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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,364	03/15/2001	Yeshayahu Redler	1336	6159

7590

01/19/2006

Edward Langer, Pat. Atty
c/o Shibolet, Yisraeli, Roberts, Zisman & Co.
Empire State Building
350 Fifth Avenue, 60th Floor
New York, NY 10118

EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,364

Applicant(s)

REDLER, YESHAYAHU

Examiner

Michael J. Simitoski

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 12-15 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 12-15 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 11/28/2005 was received and considered.
2. Claims 1, 12-15 & 22 are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 12-15 & 22 have been considered but are moot in view of the new ground(s) of rejection.
4. As an initial note, the status identifiers used to identify the claims are not the correct status identifiers according to 37 CFR §1.121(c) but are, however, acceptable alternatives according to MPEP §714.
5. Applicant's response (p. 8) argues that claims 1 and 22 comprise a public key algorithm. However, it is noted that claim 22 does not recite this limitation.
6. Applicant's response (p. 9, ¶3) argues that Clark does not disclose that the encrypted circuitry is integrated into a keyboard in a secure Internet communication format. However, the claims do not recite the integration of circuitry in a certain format.
7. Applicant's response (p. 10, ¶2) argues that Clark does not utilize a dynamic key exchange mechanism, however, the claimed apparatus does not utilize a dynamic key exchange mechanism.

Claim Objections

8. Claim 22 is objected to because of the following informalities:

On page 5, "via said encryption unit" is believed to mean "via said standard data entry device"

On page 5, “wherein said encryption unit and said electronic device comprise are” should be replaced with “wherein said encryption unit and said electronic device ~~comprise~~ are”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 12-15 & 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification discloses the RSA algorithm (p. 11) and that Level I security is intended for purchases via the Internet (p. 13), but does not disclose the limitation “secure Internet communication format enabling dynamic exchange of system encryption keys”. For the purposes of this Office Action, “secure Internet communication format” is understood to mean any data format that can be sent over the Internet by the computer.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1, 12-15 & 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether “enabling dynamic exchange of public

keys” is limiting “secure Internet communication format” or “the computer system”. For the purposes of this Office Action, “enabling dynamic exchange of public keys” is understood to limit “the computer system”.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 14-15 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,895,502 to **Fraser** in view of U.S. Patent 5,517,569 to **Clark**.

Regarding claim 1, Fraser discloses a secure device in a computer system adapted for Internet communication (col. 8, lines 36-40), said device comprising means for at least one of entry, collection and reading of data information (col. 12, lines 61-67), controller means/card reader and smart card (Fig. 1) comprising a public key algorithm (col. 13, lines 1-2) for encoding and decoding (col. 14, lines 1-4) for presentation to the computer system in a secure Internet communication format (col. 8, lines 36-40) and means/reader and smart card (Fig. 1) associated with said controller for processing said encoded data information by performing thereon at least one operation amongst operations including encryption, decryption, data manipulation and non-volatile storage, said processed encoded data information being transmitted within the computer system as encrypted data (col. 14, lines 45-49), and later decrypted and decoded for use at a remote location/server (col. 14, lines 50-57), wherein said controller means is an encryption unit

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and said processing means comprises an electronic device capable of encrypting and decrypting and storing data entered via said secure device (col. 13, lines 1-8), and wherein said device contains non-volatile memory (col. 8, line 64 – col. 9, line 9). Fraser lacks explicitly a secure keyboard device and said encryption unit and said electronic device being embedded within said secure device as a single integrated device. However, Clark teaches that a secure keyboard device is useful for encrypted confidential information in the keyboard such that confidential data such as a PIN is transmitted to a PC in encrypted form (col. 2, lines 19-48) where the encryption circuitry is incorporated into the keyboard for convenience and to avoid the need for a separate keypad (col. 4, lines 35-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fraser to embed the invention of Fraser into a single integrated secure keyboard device. One of ordinary skill in the art would have been motivated to perform such a modification to gain the benefit of convenience and to avoid the need for a separate keyboard or keypad, as taught by Clark (col. 2, lines 19-48 & col. 4, lines 35-41).

Regarding claim 14, Fraser discloses a command interpreter that operates to manipulate commands (col. 8, lines 54-58).

Regarding claim 15, Fraser discloses means/secure device for preventing unauthorized use of software programs (col. 7, lines 2-16).

Regarding claim 22, Fraser discloses a secure device in a computer system adapted for Internet communication (col. 8, lines 36-40) performing at least one of entry, collection and reading of data information (col. 12, lines 61-67) via a standard data entry device/actuator, encoding said data information within said standard data entry device (col. 14, lines 1-4) for

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presentation to the computer system in a secure Internet communication format (col. 8, lines 36-40) and processing said encoded data information by performing thereon at least one operation amongst operations including encryption, decryption, data manipulation and non-volatile storage, said processed encoded data information being transmitted within the computer system as encrypted data (col. 14, lines 45-49), and later decrypted and decoded for use at a remote location/server (col. 14, lines 50-57), wherein said encoding step is performed by an encryption unit and said processing step is performed by an electronic device capable of encrypting and decrypting and storing data entered via said standard data entry device (col. 13, lines 1-8), and wherein said device contains non-volatile memory (col. 8, line 64 – col. 9, line 9). Fraser lacks explicitly a secure keyboard device and said encryption unit and said electronic device being embedded within said secure device as a single integrated device. However, Clark teaches that a secure keyboard device is useful for encrypted confidential information in the keyboard such that confidential data such as a PIN is transmitted to a PC in encrypted form (col. 2, lines 19-48) where the encryption circuitry is incorporated into the keyboard for convenience and to avoid the need for a separate keypad (col. 4, lines 35-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fraser to embed the invention of Fraser into a single integrated secure keyboard device. One of ordinary skill in the art would have been motivated to perform such a modification to gain the benefit of convenience and to avoid the need for a separate keyboard or keypad, as taught by Clark (col. 2, lines 19-48 & col. 4, lines 35-41).

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15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fraser**, as applied to claim 1 above, in view of Microsoft Press Computer Dictionary, Third Edition, by **Microsoft**. Fraser discloses a ROM (col. 9, lines 1-5), but lacks explicitly EEPROM. However, Microsoft teaches that EEPROM useful for stable storage for long periods without electricity while still allowing reprogramming (p. 170). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fraser to store secure data in an EEPROM. One of ordinary skill in the art would have been motivated to perform such a modification to gain the well-known benefits of reprogramming and stable storage, as taught by Microsoft (p. 170).

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fraser**, as applied to claim 1 above, in view of U.S. Patent 5,943,624 to Fox et al. (**Fox**). Fraser, as modified above, discloses a secure keyboard, as taught by Clark containing a smart card reader and system, but lacks the device including secure, protected encryption keys and data as an internal and integral non-removable element. However, Fox teaches that it is known to integrate a smart card into a device such as a cellular phone to provide ease of use and enhanced security from theft or loss (col. 2, lines 10-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to integrate the functionality and secure key memory of Fraser into a non-removable element. One of ordinary skill in the art would have been motivated to perform such a modification to gain the benefits of ease of use and enhanced security from theft or loss, as taught by Fox (col. 2, lines 10-30).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

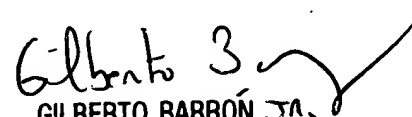
(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS
January 5, 2006



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